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In re Application of
DOLLY, et al.
U.S. Application No.: 10/049,967
PCT No.: PCT/GB00/03196
Int. Filing Date: 18 August 2000
Priority Date: 20 August 1999
Attorney Docket No.: 20020065.ORI
For: ISOFORMS OF SNARE MOLECULES AND
THE USES THEREOF IN MODULATION OF
CELLULAR EXOCYTOSIS

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 09 May 2003 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 10 January 2003, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(a) to accept the present application without the signatures of inventors James O. DOLLY, Nadiem MOHAMMED and Patrick G. FORAN. Applicant was afforded two months to file any request for reconsideration.

On 09 May 2003, applicant responded with the present renewed petition; a petition for a two-month extension of time and a check for \$410.00 as payment of the two-month extension of time fee. With the filing of the petition for a two-month extension of time, applicant's petition is considered to be timely filed.

DISCUSSION

As detailed in the decision mailed 10 January 2003, a petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant previously satisfied items (1), (3) and (4).

As to item (2), applicant's original petition filed 11 October 2002 was dismissed in part because applicant had not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to inventors James O. DOLLY, Nadiem MOHAMMED and Patrick G. FORAN. Applicant has presently provided declarations Dr. Stephanie J. Pilkington and Richard Garraway as evidence that the inventors have been provided with complete copies of the application papers. Specifically, Mr. Garraway states:

It is within my personal knowledge that in the course of attempting to obtain a signed Declaration, Power of Attorney and Petition for the corresponding United States application, each of the four inventors, Gregory A. O'Sullivan, James O. Dolly, Nadiem Mohammed and Patrick G. Foran, have been presented with at least one complete copy of the patent application for his records.

Dr. Pilkington declares:

To the best of my knowledge and belief, each of the inventors, Gregory A. O'Sullivan, James O. Dolly, Nadiem Mohammed and Patrick G. Foran, [have and] have had in their possession copies of the entire specification at least since the filing of the corresponding PCT application.

Dr. Pilkington's statement is insufficient as to showing that the inventors in question were in fact presented with complete copies of the application papers. Her statement is merely to the best of her knowledge and belief. Mr. Garraway avows to a personal knowledge that the inventors in question were in fact presented with complete copies of the application papers. However, he further states that he began work on the case in August, 2002 and attests to a very detailed listing of facts from 12 August 2002 to 18 February 2003. Only on 18 February 2003 is there a note that Nadiem Mohammed and Patrick G. Foran were sent "additional copies of the specification." However, it is impossible to ascertain how Mr. Garraway gained the first-hand knowledge that the papers were in fact provided to the non-signing inventors as required by 37 CFR 1.47(a) and Section 409.03(d) of the MPEP.

As to the refusals of the inventors MOHAMMED AND FORAN, it is unclear from the declaration of Mr. Garraway whether he personally attended the 20 September 2002 meeting with inventors MOHAMMED AND FORAN in which they allegedly stated their unwillingness to execute the declaration. As stated in the decision mailed 10 January 2003 and buttressed by applicant's exhibit "Carraway C" inventor DOLLY is willing to execute the declaration after it has been signed by the other inventors and thus, for the purposes of 37 CFR 1.47(a), is not refusing to sign.

For the reasons stated above, it would not be appropriate to accept the application without the signatures of James O. DOLLY, Nadiem MOHAMMED and Patrick G. FORAN under 37 CFR 1.47(a) at this time.

CONCLUSION

Applicant's renewed petition under 37 CFR 1.47(a) is **DISMISSED**.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Please direct future correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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